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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,886	09/04/2003	Kimmo Laakkonen	915-006.021	1554

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EXAMINER
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WHIPPLE, BRIAN P

ART UNIT	PAPER NUMBER
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2452

MAIL DATE	DELIVERY MODE
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07/20/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/656,886

**Applicant(s)**

LAAKKONEN, KIMMO

**Examiner**

BRIAN P. WHIPPLE

**Art Unit**

2452

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 April 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 4-6, 9, 14-18 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-6, 9, 14-18 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

#### **DETAILED ACTION**

1. Claims 1-2, 4-6, 9, 14-18, and 21 are pending in this application and presented for examination.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/22/10 has been entered.

#### ***Response to Arguments***

3. The applicant's arguments with respect to claims 1-2, 4-6, 9, 14-18, and 21 have been considered, but are moot in view of the new ground(s) of rejection.

#### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 9 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Recent Office guidelines indicate that a computer readable storage structure may be interpreted as transitory embodiments such as carrier waves or signals. For example, a carrier wave may be interpreted as temporarily storing computer program code as they are transmitted from point A to point B. These Office guidelines suggest amending to direct the claim to a "non-transitory" computer readable storage structure.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-2, 4-6, 9, 14-18, and 21, are rejected under 35 U.S.C. 103(a) as being unpatentable over Theimer et al. (Theimer), U.S. Patent No. 5,493,692, in view of Baker et al. (Baker), U.S. Publication No. 2004/0049696 A1.

8. As to claim 1, Theimer discloses a method for controlling the handling of push type e-mails on a mobile terminal device (Abstract), comprising:

selecting a user profile (Col. 25, ln. 17-26) on the basis of automatically received position information of said mobile terminal device (Abstract; Col. 8, ln. 52-58; Col. 9, ln. 64 – Col. 10, ln. 7, “user’s context and environment, such as current location... user’s preferences may be dynamically changed by... changing the profile”; Col. 25, ln. 27-45), said user profile regarding the handling of push type e-mails on said mobile terminal device (Col. 25, ln. 17-26, 46-51, and 55-57), wherein said selected user profile comprises push type e-mail enabled or push type e-mail disabled (Abstract; Col. 25, ln. 17-26, 46-51, and 55-57; in order to deliver e-mail, when and where appropriate, the display device receiving the e-mail must have push type e-mail enabled by the activation of necessary hardware and software components required to receive push type e-mails in the display device; the limitation refers to the “enabled... or disabled” in the alternative only and therefore any combination of enabled and/or disabled properly rejects the claim, in this case the enabled scenario has been cited),

controlling at said mobile terminal device (Col. 25, ln. 55-57; “a user may specify...”) the handling of push type e-mails according to said selected user profile (Col. 25, ln. 46-51), comprising enabling push type e-mail or disabling push type e-mail by activating or deactivating of a hardware or software component required to receive push type e-mails in

the mobile terminal device (Abstract; Col. 25, ln. 17-26, 46-51, and 55-57; in order to deliver e-mail, when and where appropriate, the display device receiving the e-mail must have push type e-mail enabled by the activation of necessary hardware and software components required to receive push type e-mails in the display device; the limitation refers to the "enabling... or disabling" and "activating or deactivating" in the alternative only and therefore any combination of enabling and/or disabling and activating and/or disabling properly rejects the claim, in this case the enabling and activating have been cited).

          Theimer is silent on selecting a user profile stored in said mobile terminal device, filtering received push type e-mail received by the mobile terminal device according to a sender based filter characteristic selection, wherein the filter characteristics are defined in said selected user profile, and

          storing at least one filtered push type e-mail of the received push type e-mail in a manner not visible to said selected user profile when the at least one filtered push type e-mail does not pass the filter characteristics of said selected user profile.

          However, Baker discloses selecting a user profile stored in said mobile terminal device ([0042], the user profile may be "packaged with the e-mail" and therefore will be present on the recipient's system when it receives the e-mail; [0078], an executable module is included with the e-mail; [0079], ln. 10-16, the executable module governs the access rights of the device accessing the e-mail),

filtering received push type e-mail received by the mobile terminal device according to a sender based filter characteristic selection([0075]; [0076]; the sender of an e-mail creates access rights for the e-mail in a "privileged profile" that is included with the e-mail after it is sent as an executable module), wherein the filter characteristics are defined in said selected user profile ([0042], the user profile may be "packaged with the e-mail" and therefore will be present on the recipient's system when it receives the e-mail; [0078], an executable module is included with the e-mail; [0079], ln. 10-16, the executable module governs the access rights of the device accessing the e-mail and filters in ways such as rendering a user "unable to view the e-mail"), and

storing at least one filtered push type e-mail of the received push type e-mail in a manner not visible to said selected user profile when the at least one filtered push type e-mail does not pass the filter characteristics of said selected user profile ([0042], the user profile may be "packaged with the e-mail" and therefore will be present on the recipient's system when it receives the e-mail; [0078], an executable module is included with the e-mail; [0079], ln. 10-16, the executable module governs the access rights of the device accessing the e-mail and filters in ways such as rendering a user "unable to view the e-mail").

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Theimer in the aforementioned manner as taught by Baker in order to include access rights for an e-mail with the e-mail itself, so that it may be

stored on each recipient, thereby enforcing the sender's desired access rights at each recipient.

9. As to claim 2, Theimer and Baker disclose the invention substantially as in parent claim 1, including said controlling of the handling of push type e-mails comprises notifying a push type e-mail server of a mobile communication network about the handling of push type e-mails according to said determined user profile (Theimer: Fig. 1; Fig. 17; Col. 24, ln. 49-60).

10. As to claim 4, Theimer and Baker disclose the invention substantially as in parent claim 1, including said user profile comprises a predetermined filter acting on the received push type e-mails (Theimer: Col. 25, ln. 23-26 and 52-57), said filter selecting push type e-mails according to properties of said received emails (Theimer: Col. 25, ln. 23-26 and 52-57), wherein said method further comprises:

receiving a push type e-mail (Theimer: Col. 25, ln. 6-12), and

filtering said received e-mail according to said properties (Theimer: Col. 25, ln. 23-26 and 46-57).

11. As to claim 5, Theimer and Baker disclose the invention substantially as in parent claim 2, including storing said received push type e-mail (Theimer: Fig. 17, items 430, 432,



and 436; Col. 25, ln. 46-51; it may be interpreted that if the application waits for a change in context before reattempting delivery that it must store the e-mail until the reattempt)

12. As to claim 6, Theimer and Baker disclose the invention substantially as in parent claim 1, including said terminal device further comprises sensors (Theimer: Fig. 1; Col. 12, ln. 62-66), said method further comprising:

determining of sensor data (Theimer: Fig. 1; Col. 12, ln. 62-66), and  
changing said user profile according to said determined sensor data (Theimer: Fig. 1;  
Col. 9, ln. 64 – Col. 10, ln. 7; Col. 12, ln. 62-66; Col. 25, ln. 17-26).

13. As to claims 9 and 14-15, the claims are rejected for reasons similar to claim 1 above.

14. As to claim 16, the claim is rejected for reasons similar to claim 4 above.

15. As to claim 17, the claim is rejected for reasons similar to claim 2 above.

16. As to claim 18, the claim is rejected for reasons similar to claim 6 above.

17. As to claim 21, the claim is rejected for reasons similar to claims 1-2 above.

***Conclusion***

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See the Notice of References Cited (PTO-892).

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN P. WHIPPLE whose telephone number is (571)270-1244. The examiner can normally be reached on Mon-Fri (8:30 AM to 5:00 PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thu Nguyen can be reached on 571-272-6967. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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7/18/10

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